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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,107	01/08/2002	Margaret Gardner MacPhail	AUS920010596US1	6316

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International Business Machines Corporation
Intellectual Property Law Department
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Austin, TX 78758

EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,107

Applicant(s)

MACPHAIL, MARGARET
GARDNER

Examiner

CamLinh Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is response to the Appeal Brief filed on 6/7/2005. Consequently, claims 1 – 36 are pending for prosecution.

2. In view of the Appeal Brief filed on 6/7/2005, PROSECUTION IS HEREBY REOPENED. New ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 8 – 11, 13 – 15, 20 – 23, 25 – 27, 32 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (U.S. 6,674,439).

♦ As per claim 1, 13, 25,

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Shin discloses a computer controlled database system for providing a user with database output through a user interface having predefined dimensions limiting the capacity of each iterative segment of output comprising:

- “Database means (Fig. 2, element 30) for storing a plurality of different types of output data” See col. 10, lines 21 - 26.
 - “Means for storing in said database data segments for each of the different types of stored data, each segment having a capacity limited by said predefined dimensions of said user interface” See Fig. 4, elements 403- 404, col. 11, lines 45 – 50, col. 12, lines 20 – 37, col. 14, lines 10 – 18. The user can set different sizes for different images/texts and they can be stored in the storage unit 404. Therefore, the setting sizes correspond to the “data segments” for each of the different types of stored data (images/texts).
 - “Each segment having a capacity limited by said predefined dimensions of said user interface” See Fig. 1, element 10 – 11. Shin teaches that the PDA or other display screens are used in the invention. Therefore, each device has its own “predefined dimension” of user interface.
 - “Means (Fig. 4, element 408) for providing a plurality of strings of said segments, each string including a sequence of segments of one different type of stored data” see col. 12, lines 41 - 63
- “Means (Fig. 4, element 401) for enabling a user to select one of said strings of segments to be output” See col. 12, lines 29 – 30.

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- “Means (Fig. 4, element 412 – 413) for outputting said selected string of segments at said user interface” See col. 12, lines 57 – 63.

Shin does not expressly show the storing means in the database store different types of stored data, each segments having a capacity limited by said predefined dimensions of user interface.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The storing means in the database store different types of stored data, each segments having a capacity limited by said predefined dimensions of user interface steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store different types of stored data, each segments having a capacity limited by said predefined dimensions of user interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

♦ As per claim 2, 14, 26,

- “User interface is a computer controlled display interface” See Fig. 1, element 20.
- “Said database means for storing said output data is connected to said user interface through a network” See col. 11, lines 25 – 28.

♦ As per claim 3, 15, 27,

- “Said network is the World Wide Web” see col. 19, lines 15 - 20.

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◆ As per claim 8, 20, 32,

- “Said computer controlled display interface is on a receiving display station on said WWW” See Fig. 10, col. 19, lines 15 - 20.

◆ As per claim 9, 21, 33,

- “Said means for providing said strings of data segments are associated with said database means connected by the World Wide Web to said receiving display station” See Fig. 10, col. 19, lines 15 - 20.

◆ As per claim 10, 22, 34,

- “Said World Wide Web further includes a service provider for organizing and providing data from database sources on said World Wide Web to said receiving display station; and said service provider includes said means for providing said plurality of strings of said segments to said receiving display station” See Fig. 1, element 18 – 19, col. 9, lines 50 – 51.

◆ As per claim 11, 23, 35,

- “Said receiving display station further includes means for selecting and displaying one of said plurality of strings of said segments provided to said receiving display station” see col. 9, lines 51 – 59.

5. Claims 4 – 7, 12, 16 – 19, 24, 28 – 31, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (U.S. 6,674,439) in view of Randal Lee Guck (U.S. 5,864,870).

◆ As per claim 4 – 7, 16 – 19, 28 – 31,

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Shin does not clearly disclose that the string includes a sequence of number of segments of image, text, video, or audio type of data. However, Shin teaches that the analyzing unit would analyze the contains of data such as linked location (col. 21, lines 65 – col. 22, line 3). Clearly, Shin implicitly teaches that if an image has relationship with another one, they should be displayed in a sequence of segments. In addition, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The string includes a sequence of number of segments of image, text, video, or audio type of data steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

On the other hand, Guck discloses a database that can organize different data formats (See Fig. 4A). Therefore, when a user selects a text file, the next level should include other text files or the sequence of the segment.

As a result, if the limitations of the above were not inherent in Shin system, it would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Guck into the system of Shin because the combination would provide the user a clearly interface of a directory information, allowing the user select information as user desired, and because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

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6. Claims 12, 24, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin et al (U.S. 6,674,439) in view of Benschoter et al (U.S. 2003/0101230).

♦ As per claim 12, 24, 36

Shin does not clearly disclose that “said receiving display station further includes means for changing the order of segments to be displayed in a selected one of said plurality of strings of segments”. However, it is well known in the art that a user can customize the display by copy and paste or drag and drop the data information. Benschoter discloses a system that allows the user to select the order of video clips to be played (See Fig. 7, paragraph 0039). Benschoter teaches different ways to rearrange the list by using the button arrow 745 to arrange the video clips or using drag-and-drop method. It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Benschoter into the system of Shin because the combination would provide the user the flexibility in arrange data item based on the user desires.

Response to Arguments

7. Applicant's arguments with respect to claims 1 - 36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272-4024. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571 – 273 - 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER